

Appln. Serial No. 09/712,101
Reply to Office Action Mailed July 14, 2004

REMARKS

In the Office Action dated July 14, 2004, claims 2, 4-12, and 21-33 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,412,004 (Chen) in view of U.S. Patent No. 6,360,262 (Guenthner).

As discussed in the previous Reply to Office Action, there existed no motivation or suggestion to combine the teachings of Chen and Guenthner in the manner proposed by the Office Action. The following rationale was provided in the Office Action regarding how Chen and Guenthner can be combined:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Guenthner to let the at least one streaming media client receives the setup information from one of the plurality of streaming media servers since such methods were conventionally employed in the art to allow the system to select the "best provider" and redirect or forward the request to that server as **operating in "handoff" mode**, to eliminate the bottleneck problem associated with the limited speed of a single multimedia server, reduce network congestion and increase the fault tolerance of the whole system.

7/14/2004 Office Action at 4 (emphasis in original).

However, the argument made by the Office Action regarding why Chen and Guenthner can be combined ignores the fact that modifying the system of Chen with the teachings of Guenthner would render the system of Chen unsatisfactory for its intended purpose. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01 (8th ed., Rev. 2) at 2100-131.

Chen describes an arrangement in which a metasever receives a request from a client, and in response to the request, the metasever supplies the *client* computer with a list of possible multimedia servers. Chen, 10:19-25. In response, the client computer connects to the first available server from the list of eligible multimedia server names. Chen, 10:27-29. In other words, in Chen, it is the client that has to select a server from a list provided by the metasever to the client. This necessarily means that the client has to first perform selection of a multimedia server, before the client can establish any type of

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communication between the client and the multimedia server. The opposite is performed in Figure 4B of Guenthner, which refers to a web client sending a request for a resource object to a resource router, which then forwards the request to a server. The server then sends its response back to the client. Guenthner, 4:64-5:6. The procedure in Figure 4B of Guenthner would violate the teachings of Chen, which requires that the metaserver first send a list of possible multimedia servers to the client so that the client can select the multimedia server to connect to for retrieving multimedia content (Chen, 6:41-49).

Modifying the Chen system with the Guenthner Figure 4B arrangement would cause the metaserver to send the list of multimedia servers to one of the multimedia servers instead of the client, which would effectively prevent the client of Chen from selecting a multimedia server from the list. As the proposed modification of Chen based on Guenthner's teachings would render the Chen system unsatisfactory for its intended purpose, it is respectfully submitted that there existed no motivation or suggestion to combine Chen and Guenthner.

Moreover, there simply did not exist any desirability to incorporate the teachings of Guenthner into the system of Chen. It is well established law that "[t]he mere fact that the prior art could be so modified would not have made the modification **obvious** unless the prior art suggested the **desirability** of the modification." *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). As the Federal Circuit has stated, "virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). "Most, if not all, inventions are combinations and mostly of old elements." *Id.* "Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *Id.*

In Chen, three distinct types of nodes are provided on a network: client computers, multimedia servers, and metaservers. Each metaserver is configured to store

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a metasever database. Chen, 6:6-10. The information in the metasever database is used to apply a selection algorithm, by the metasever, to determine a list of multimedia servers that a client can use. Chen, 6:41-45. The intelligence for selecting a list of media servers thus resides in the metasever. This intelligence enables the metasever to produce a list, with such list provided to a client to allow the client to make another selection.

The proposed modification of Chen based on the teachings of Guenthner, as proposed by the Office Action, would change the operation such that instead of sending the list from the metasever to the client, the list would be sent by the metasever to the multimedia server of Chen. There is absolutely no reason for the metasever to send its list of potential multimedia servers to any one of the multimedia servers, as such a list would be completely useless to any multimedia server. The operation of Chen depends on the fact that this list of potential multimedia servers is communicated to a client to allow the client to make the selection. In other words, according to Chen, there simply is no reason to involve a multimedia server in the selection of a multimedia server. A person of ordinary skill in the art looking to the teachings of Chen and Guenthner would not have been motivated to change the operation of Chen to incorporate un-related teachings of Guenthner. In fact, modifying the technique employed in Chen to cause a listing of multimedia servers to be sent to any of the multimedia servers would make the multimedia server selection process more inefficient. Therefore, it is respectfully submitted that, because no desirability existed to incorporate the teachings of Guenthner into Chen, no motivation or suggestion existed to combine these references. *A prima facie* case of obviousness has thus not been established with respect to claim 4.

A prima facie case of obviousness has also not been established with respect to independent claim 21. The Office Action indicated that claim 21 was rejected "under the same rationale" as claims 2 and 4-12. Claim 21 recites a method that includes a master server receiving a user request for a media file from a streaming media client; the master server selecting, based the user request, one of a plurality of streaming media servers for handling the user requests for the media files; and the master server sending to the selected one of the plurality of streaming media servers a request to enable the selected streaming media server to send information to the streaming media client for establishing

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a streaming session between the streaming media client and the selected streaming media server.

As discussed above with respect to claim 1, the teachings of Chen and Guenther are inconsistent with each other, such that modifying the system of Chen to incorporate the teachings of Guenther would render the Chen system inoperative for its intended purpose. More specifically, Chen describes an environment in which a metasever sends a list of media servers to a *client* computer to enable the *client computer* to select from that list. The ability of a client to select from a list of candidate media servers would not be achievable using the Fig. 4B arrangement of Guenther, where a resource router forwards a request from a client to an appropriate server, with the server then sending its response directly back to the client. If Chen were modified such that its metasever sends a list of candidate media servers to one of the media servers, then the goal of enabling a client to select from a media server on such a list would be defeated. This is a clear indication that no motivation or suggestion existed to combine the teachings of Chen and Guenther.

Moreover, as discussed above, there simply did not exist any reason or desirability to incorporate the teachings of Guenther into the system of Chen. In fact, incorporating the teachings of Guenther into Chen would make the system more inefficient.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 21.

Independent claim 28 is similarly allowable over the asserted combination of Chen and Guenther.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. Moreover, with respect to claim 24 (which depends from claim 22), the Office Action has failed to adequately explain how the additional element recited in claim 24 is taught or suggested by the asserted combination of Chen and Guenther. The only explanation of the rejection of claim 24 is as follows: "Claims 21-33 are corresponding method and system claims of method claims 2 and 4-12; therefore, they are rejected under the same rationale." 7/14/2004 Office Action at 6. However, the element recited in claim 24 does not exist in any of claims 2 and 4-12. Claim 24

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expressly recites contacting each of the streaming media servers to determine its operational status, wherein selecting one of the plurality of streaming media servers is further based on the determined operational status. Such an element does not exist in either Chen or Guenther.

Similarly, with respect to claim 25, which depends from claim 22, the Office Action has failed to adequately explain how the references teach or suggest the additional element of claim 25. Claim 25 recites examining bandwidth history of the plurality of streaming media servers, wherein selecting one of the plurality of streaming media servers is further based on the bandwidth history. This element does not exist in any of the claims 2 and 4-12. This element is also not taught or suggested by the references.

The Office Action has also failed to adequately explain how the references teach or suggest claim 32, which depends from claim 28. Claim 32 recites a module to further exam bandwidth history of the plurality of streaming media servers, where the module selects one of the plurality of streaming media servers based on the examination of the bandwidth history. This element is not recited in any of claims 2 and 4-12, and is not taught or suggested by the references.


In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to dependent claims 24, 25, and 32 for the additional reasons stated above.

Allowance of all claims is respectfully requested. No fee is believed to be due at this time, however, the Commissioner is authorized to charge any required fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 08-2025 (200308253-01).

Respectfully submitted,

Date: _____

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